

REMARKS

Claims 8-20, 22, 23, 27-30, 37-45, 48-50, and 52-60 are pending in the application.

By the foregoing Amendment, claims 8-16, 23, 27-30, 37-41, 49, 50, and 52-58 are amended. New claims 59 and 60 are added. Claims 1, 31, and 51 are canceled without prejudice or disclaimer.

Claims 9, 10, and 50, 52, and 53 are amended as discussed hereinafter. Claims 8 and 11-16 are amended to depend from claim 9; claims 23 and 27-30 are amended to depend from claim 10; claims 36-39, 41, and 54 are amended to depend from claim 50; claim 40 is amended to depend from claim 39; claims 49 and 55-57; and claim 58 is amended to depend from claim 57. Additional amendments are made to the dependent claims for better conformity with their base claims.

These changes are believed not to introduce new matter, and entry of the Amendment is respectfully requested.

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections, and withdraw them.

Rejections under 35 U.S.C. § 101

In paragraph 2 of the Office Action, claims 1, 8-20, 22, 23, and 27-30 were rejected under section 101; and in paragraph 3, claims 31, 36-45, and 48-58 were rejected under section 101. Both rejections are predicated at least in part on the assertion that a font is not a statutory class of subject matter. Process claims 31, 36-45, and 48-58 also were rejected on the basis that the claimed process failed the “useful, concrete and tangible result” test. These rejections are believed to be overcome by the foregoing amendments to claims 9, 10, and 50, 52, and 53.

It is noted that the Federal Circuit, in its October 30, 2008 opinion in *In re Bilski*, Docket No. 2007-1130, rejected the “useful, concrete and tangible result” test, holding “we also conclude that the ‘useful, concrete and tangible result’ inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.” As enunciated by the court in *Bilski*, the “machine-or-transformation” test “is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.” The proposed amendments to the process claims ties the claims to a particular machine, i.e., a computer. It is also respectfully submitted that they transform data in a manner compliant with section 101.

In answer to the question “[w]hich, if any, of these processes qualify as a transformation or reduction of an article into a different state or thing constituting patent-eligible subject matter?” the court looked to the CCPA’s opinion in *In re Abele*, 684 F.2d 902 (CCPA 1982). In *Abele*, the broad independent claim was directed to a process of graphically displaying variances of data from average value, without specifying “any particular type or nature of data” or “how or from where the data was obtained or what the data represented,” while one of the dependent claims “specified that ‘said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner’”; and the dependent claim was found to be directed to statutory subject matter, while the independent claim was not. *Bilski*, pp. 25-26. In its analysis of *Abele*, the *Bilski* court stated at p. 26:

[T]he electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented. We believe this is faithful to the concern the Supreme Court articulated as the basis for the machine-or-

transformation test, namely the prevention of pre-emption of fundamental principles. So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle.

Implicit in the court's above-quoted statement is that "a visual depiction [of data] that represents specific physical objects or substances" constitutes statutory subject matter. The process as recited in claims 50, 52, and 53 provides data for visual display (on a computer display screen or on a physical print medium), where the data represents a specific physical object -- a dynamic font. Dependent claims 36, 37, 38, 39, 49, 55, 56, 57, and 60 explicitly recite displaying or printing steps.

Further guidance is provided by MPEP 1504.01(a), which is directed to compliance of design applications for computer-generated icons with the "article of manufacture" requirement of 35 U.S.C. § 171. According to MPEP 1504.01(a):

The USPTO considers designs for computer-generated icons embodied in articles of manufacture to be statutory subject matter eligible for design patent protection under 35 U.S.C. 171... "We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design 'for an article of manufacture.'" *In re Hruby*, 373 F.2d 997, 1001, 153 USPQ 61, 66 (CCPA 1967) (design of water fountain patentable design for an article of manufacture). The dependence of a computer-generated icon on a central processing unit and computer program for its existence itself is not a reason for holding that the design is not for an article of manufacture.

MPEP 1504.01(a)III provides with respect to type fonts:

Traditionally, type fonts have been generated by solid blocks from which each letter or symbol was produced. Consequently, the USPTO has historically granted design patents drawn to type fonts. USPTO personnel should not reject

claims for type fonts under 35 U.S.C. 171 for failure to comply with the “article of manufacture” requirement on the basis that more modern methods of typesetting, including computer-generation, do not require solid printing blocks.

MPEP 1504.01(a)IV further provides with respect to computer-generated icons:

Computer generated icons including images that change in appearance during viewing may be the subject of a design claim.

A computer-generated dynamic font, particularly one that is displayed on a computer display screen, is in substance very similar to a computer-generated icon that changes in appearance during viewing.

Still further, the case law interpreting Title 35 does not make any substantive differentiation between a “manufacture” (in defining statutory subject matter for utility patents under section 101) and an “article of manufacture” (in defining statutory subject matter for design patents under section 171). In fact, the *Bilski* opinion appears to use “article” as a synonym for “manufacture.” Thus, something that qualifies as an article of manufacture for purposes of section 171 should also qualify as an article or manufacture for purposes of section 101.

The preambles of article claims 9 and 10 are amended to specify that the invention is a *computer-generated dynamic font for display on a computer display screen or for printing on a physical print medium*, and the preambles of article claims 50, 52, and 53 are amended to specify that the invention is a process of generating a dynamic font for display on a computer display screen or printing on a physical print medium, by analogy to the pronouncement of MPEP 1504.01(a) that “if an application claims a computer-generated icon shown on a computer screen, monitor, other display panel, or a portion thereof, the claim complies with the ‘article of manufacture’ requirement of 35 U.S.C. 171.”

Clearly, then, the claims directed to a computer-generated dynamic font are directed to an article of manufacture, and the claims directed to a computer-implemented process of generating a dynamic font are tied to a statutory class and result in the transformation of an underlying article of manufacture.

In view of the foregoing, it is respectfully submitted that the invention as recited in claims 9, 10, 50, 52, and 53 and the claims depending therefrom are directed to statutory subject matter; and that the rejections should be withdrawn.

Allowable Subject Matter

Claims 9, 10, and 50-53 have not been rejected based on prior art. Therefore, it is understood that those claims, if rewritten in independent form, should be allowable, assuming that the rejection under section 101 is overcome.

Rejections under 35 U.S.C. § 103

1. Claims 1, 8, 13-20, 22, 23, 28-31, 36, 38-45, 48, 49, and 56-58

In paragraph 7 of the Office Action, claims 1, 8, 13-20, 22, 23, 28-31, 36, 38-45, 48, 49, and 56-58 were rejected under section 103(a) as being unpatentable over Chepaitis '108 in view of Desrosiers, and further in view of Jeffrey. This rejection is overcome by the cancellation of claims 1 and 31; and by the amendment of claims 8 and 13-16, to depend from claim 9, the amendment of claims 23 and 28-30 to depend from claim 10, the amendment of claims 36, 38, 39, and 41 to depend from claim 50, the amendment of claim 39 to depend from claim 40, the amendment of claims 49, 56, and 57 to depend from claim 52, and the amendment of claim 58 to depend from claim 57.

2. Claims 11 and 54

In paragraph 16 of the Office Action, claims 11 and 54 were rejected under section 103(a) as being unpatentable over Chepaitis '108 in view of Desrosiers and Jeffrey, and further in view of Fujisawa et al. This rejection is overcome by the cancellation of claims 11 and 54.

3. Claims 12, 27, 37, and 55

In paragraph 18 of the Office Action, claims 12, 27, 37, and 55 were rejected under section 103(a) as being unpatentable over Chepaitis '108 in view of Desrosiers and Jeffrey, and further in view of Prince et al. This rejection is overcome by the amendment of claim 12 to depend from claim 9, the amendment of claim 27 to depend from claim 10, the amendment of claim 37 to depend from claim 50, and the amendment of claim 55 to depend from claim 52.

Conclusion

All rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

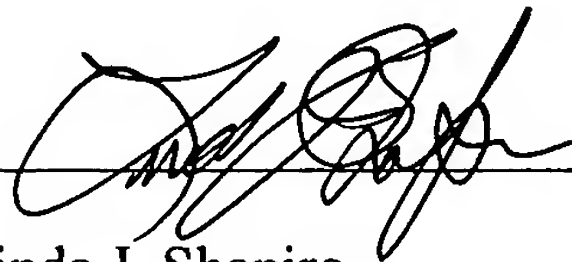
Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

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